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08/894, 156 08/15/97 BRUCHMANN

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EXAMINER

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ART UNIT	PAPER NUMBER
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1711

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 19

Application Number: 08/894,156

Filing Date: 08/15/97

Appellant(s): Bernd Bruchman et al.

Oblon, Spivak, McClelland, Maier & Neustadt
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed July 2, 1999.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

Art Unit: 1711

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on March 1, 1999 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-9 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Art Unit: 1711

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

U.S. 4,152,350	Mohring et al.	May, 1979
U.S. 4,192,936	Mohring et al.	March, 1980
U.S. 3,903,127	Wagner et al.	September, 1975
U.S. 3,976,622	Wagner et al.	August, 1976
U.S. 3,367,956	Hennig et al.	February, 1968

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a

Art Unit: 1711

later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mohring et al. ('350 or '936) in view of Wagner et al. ('127 or '622) and Hennig et al. ('956).

Mohring et al. disclose the production of biuret containing polyisocyanates having a low unreacted polyisocyanate monomer content and light color, wherein diisocyanates are reacted with an alcohol component, including tertiary alcohols; an amine component; and water. See column 3, lines 10+ and columns 4-7.

While Mohring et al. disclose the use of amines, patentees fail to disclose the use of appellants' claimed nitrogen containing stabilizer. However, appellants' claimed stabilizers were known at the time of invention to be useful agents for the production of biurets. See column 6, lines 8+; column 9, lines 9+; and column 11, lines 55+, within Wagner et al. See column 1, lines 53+ and column 2 within Hennig et al. Furthermore, Hennig et al. disclose that their biurets, derived from urea derivatives, are light in color. See examples. Additionally, it is noted that Wagner et al. disclose both amines and urea derivatives as being suitable agents for the production of biurets.

Therefore, one of ordinary skill in the art would have been motivated to utilize the nitrogen containing biuretizing agents of the secondary references in place of the amine component of Mohring et al. because one would have reasonably expected the nitrogen compounds of the primary and secondary references to function as equivalents, in view of the

Art Unit: 1711

teachings within the secondary references. It has been held that it is prima facie obvious to substitute an equivalent component for another, where equivalency is known within the art. In re Ruff, 118 USPQ 343 (CCPA 1958). Furthermore, it has been held that it is prima facie obvious to combine components, known to be useful for the same purpose, to yield a third component to be used for the very same purpose. In re Kerkhoven, 205 USPQ 1069. Therefore, the position is further taken that it would have been obvious to combine known biuretizing agents, such as tert-butanol and urea or formamide, for example, as disclosed by Wagner et al. to yield a biuretizing composition suitable for producing a biuret.

Appellants have argued that their invention differs from the prior art, because appellants utilize their stabilizer in a catalytic amount. The examiner has considered this argument; however, it is insufficient to remove the rejection because appellants' catalytic amount of stabilizer is comparable to the amounts of nitrogen containing agents used within the art. Appellants disclose that a catalytic amount of stabilizer equates to 0.01 to 2.0 mole percent of stabilizer based on isocyanate groups in (a); the examiner takes the position that this means that for every mole of isocyanate group, 0.0001 to 0.02 mole of stabilizer is used. This, in turn, equates to a molar ratio of diisocyanate to stabilizer of 5000:1 to 25:1. Mohring et al.'s examples disclose a molar ratio of diisocyanate to nitrogen containing compound of 24:1. Wagner et al. disclose a molar ratio of at least 11:1, preferably 12:1 to 40:1. The position is taken that it is immaterial with respect to what names (i.e., biuretizing agents, stabilizers, of catalysts) are used to

Art Unit: 1711

describe the components. The fact remains that equivalent compounds are being used in comparable amounts, within the processes.

Appellants have further attempted to rely upon their comparative evidence to rebut the prima facie case of obviousness; however, the position is maintained that the comparative evidence is not representative of the closest available prior art, namely Mohring et al. Mohring et al., rather than Wagner et al., is considered to constitute the closest available art in view of the similarities of the instant process and the process of Mohring et al. Furthermore, arguments pertaining to the presence or amount of allophanate groups within Mohring et al. are not considered to be relevant, because the instant claims fail to limit or exclude allophanate groups. A review of Mohring et al. reveals that the patentees were concerned with the production of biurets and that the allophanate contents are substantially exceeded by the biuret contents of the compositions. One of ordinary skill would have expected the use of tertiary alcohols to reduce the content of allophanates, as compared to using primary or secondary alcohols, because tertiary alcohols are less reactive than primary or secondary alcohols. This position is supported by a comparison of example 6 of Mohring et al., which uses tertiary butanol, with examples 1,3,4 and 5 of Mohring et al. which use methanol. Example 6 lacks allophanate groups. The position is taken that one would have been able to control allophanate content by appropriate selection of the alcohol component.

Art Unit: 1711

In response to arguments pertaining to claims 2 and 3, Mohring et al. disclose the claimed isocyanates at column 6, lines 3-33.

In response to arguments pertaining to claims 4 and 5, Mohring et al. disclose the claimed alcohols at column 3, lines 18-22 and column 5, lines 56-62.

In response to the argument pertaining to claim 6, a review of the ratios disclosed within column 4 of Mohring et al. appears to indicate that the claimed content of agent (b) is encompassed by the disclosed contents of alcohols of the patentees.

The argument with respect to claim 7 has been previously addressed.

In response to arguments pertaining to claims 8 and 9, Mohring et al. disclose the claimed subject matter at column 4, lines 44-61 and examples.

(11) Response to Argument

Appellants' arguments have been addressed with the Grounds of Rejection.

Application/Control Number: 08/894,156

Page 8

Art Unit: 1711

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Rabon Sergent
RABON SERGENT
PRIMARY EXAMINER

Sergent/JW
September 17, 1999

BOARD OF APPEALS
Assignment of Patent AppealsDocket: A Date: MARCH 20, 2002Time: 9:00 AM Hearing Room: A

<u>Cal. No.</u>	<u>Appeal No.</u>	<u>Appellant</u>	<u>Counsel</u>
36	2000-1217	BETRENIEUX, ISABELLE ET AL.	PENNIE & EDMONDS
37	2000-1846	HAYASHI, TAKAO ET AL.	OBLON, SPIVAK, MCQUELLAND
38	2000-1881	BRUCHHMAN, BERND ET AL	OBLON, SPIVAK, MCQUELLAND

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